

**REMARKS**

By this Amendment, Applicants amend claims 1, 7, 9, 16, and 19 for clarity and cancel claims 8 and 17. Accordingly, claims 1-7, 9-16, 18, and 19 are pending in this application. Applicants respectfully request reconsideration and prompt allowance of the pending claims at least in light of the following remarks.

Applicants appreciate the courtesies shown to Applicant's representative by Examiners Ries and Bashore during the October 11 personal interview. Applicants incorporate a separate record of the substance of the interview into the following remarks.

The Office Action Rejects claims 1-7, 9-16, and 19 under 35 U.S.C. §103(a) over Price, et al., "Linking by Inking: Trailblazing in a Paper-Like Hypertext" (hereinafter "Price") in view of Golovchinsky, et al., "From Reading to Retrieval: Freeform Ink Annotations as Queries" (hereinafter "Golovchinsky"). Applicants respectfully traverse the rejection.

As discussed during the personal interview, neither Price nor Golovchinsky disclose, teach, or suggest that the source document and the target document are pre-selected from the database as the source document and the target document by a user of the system before the source document is annotated, as recited in claims 1, 9, and 19.<sup>1</sup>

Both Price and Golovchinsky disclose systems and methods wherein a source document is annotated (Price pp. 33 and 34; Golovchinsky pp.19-22). Each annotation is converted into a query and an entire database is searched for other documents related to the query (Id). Importantly, according to both Price and Golovchinsky each document that is returned by the search is unknown to the user prior to the search and thus cannot be "pre-selected."

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<sup>1</sup> Applicants note that claims 1, 9, and 19 are amended to recite "the target document" to make clear that the target document must be specifically pre-selected as the target document, as opposed to simply selecting a group of documents, or database, from which an unknown target document may be searched for following the annotation of the source document. The amendment is not intended to limit the scope of the claims to only one target document. Rather by using the transitional phrase "comprising" the claim is intended cover one or more target documents in addition to the recited pre-selected target document.

Furthermore, as discussed during the personal interview, because claims 1, 9, and 19 specify that "the target document" is pre-selected as "the target document," the selection of a database or collection of documents from a database for a search without knowing which document will be returned by the search, cannot reasonably be considered pre-selecting a specific document as "the target document" to be annotated.

Thus, for example, according to Price, even if the documents of the XLIBS database are pre-selected by a user as alleged by the Office Action, no specific document has been pre-selected from the database as "the target document," as recited in claims 1, 9, and 19.

As discussed during the personal interview, the above-described deficiency of Price and Golovchinsky results from a fundamental difference between the objects of Price and Golovchinsky and the inventions recited in claims 1, 9, and 19. The systems and methods of Price and Golovchinsky search for new information (see e.g., Price, "Introduction," and Golovchinsky, "The Problem"). The system of claim 1 and the methods of claims 9 and 19 apply similar annotations to other known documents to save time and to aid in review and revision of those other known and pre-selected documents (see e.g., page 1, lines 14-21; page 3, lines 17-32). Because the systems and methods of Price and Golovchinsky help a user search for documents within a database, those documents cannot be known to a user before the search and thus cannot be "pre-selected" as "the target document."

Because neither Price nor Golovchinsky disclose, teach, or suggest that the source document and the target document are pre-selected from the database as the source document and the target document by a user of the system before the source document is annotated, claims 1, 9, and 19 are patentable over the asserted combination of Price and Golovchinsky. Further, Applicants respectfully submit that claims 2-7 and 10-16 are patentable for at least the reasons that claims 1 and 9 are patentable, as well as for the additional features they recite. Applicants respectfully request withdrawal of the rejection.

The Office Action Rejects claims 8 and 17 under 35 U.S.C. §103(a) over Price and Golovchinsky in view of U.S. Patent Application 6,363,179 to Evans et al. (hereinafter "Evans"). Applicants respectfully traverse the rejection.

By this Amendment, the features of claim 8 and 17 are incorporated into claims 1 and 9, respectively, and claims 8 and 17 are canceled. Accordingly, the rejection is inconsistent with the pending claims. However, with respect to pending claims 1 and 9, this rejection is premised upon the presumption that Price and Golovchinsky disclose, teach, or suggest all of the features of claims 1 and 9. Because, as discussed above, neither Price nor Golovchinsky disclose all of the features of claims 1 and 9, the rejection is improper. Applicants respectfully request withdrawal of the rejection.

In view of at least the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicit favorable reconsideration and prompt allowance of claims 1-7, 9-16, 18, and 19.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, Applicants invite the Examiner to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

  
James A. Oliff  
Registration No. 27,075

Jesse O. Collier  
Registration No. 53,839

JAO:JOC/tea

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**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

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